

Remarks

Favorable reconsideration of this application, in view of the above amendments and in light of the following remarks and discussion, is respectfully requested.

Claims 1-3 and 11-22 are currently pending in the application; Claims 1-3 having been amended, non-elected Claims 4-10 having been canceled without prejudice or disclaimer, and new Claims 11-22 having been added, by way of the present response.

In the outstanding Office Action, Claims 1-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,349,086 to Nishida et al. (Nishida) in view of either U.S. Patent No. 5,714,222 to Yokoyama or Japanese Publication No. 3-88148 to Okada. Applicants respectfully request that the rejection of the claims be withdrawn for the following reasons.

As stated above, Claims 1-3 have been amended in a non-narrowing manner to remedy potential informalities and to place the claims in better conformity with standard U.S. practice, and new Claims 11-17 have been added. Applicants respectfully assert that support for the changes to the claims is self-evident from the originally filed disclosure, including the original claims, and that therefore no new matter has been added.

The present invention is directed to an optical information medium. Independent Claim 1 recites a disk-shaped supporting substrate defining a center hole. An annular information recording area is disposed on the supporting substrate. Independent Claim 1 further recites an annular resin-based light-transmitting layer on the information recording area by which a laser beam is transmitted, the light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim.

Nishida is directed to an optical disc and method for manufacturing the optical disc. Applicants respectfully assert that Nishida does not teach or suggest, and the Office Action

explicitly concedes that Nishida does not teach or suggest,¹ the claimed features of a light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim, as recited in independent Claim 1.

Specifically, independent Claim 1 recites "said light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim."

The Office Action relies on Yokoyama and Okada in an attempt to remedy the deficiencies of Nishida. Applicants respectfully assert that Yokoyama and Okada do not remedy these deficiencies, however, for the following reasons.

Yokoyama is directed to an optical recording medium. As shown in Figure 3, for example, a second protective layer 6 is formed by depositing an annular ring of a photo-conductive resin composition 9 for forming the second protective layer 6, and spreading the resin composition by rotating a substrate 2.²

Applicants respectfully assert that Yokoyama does not teach or suggest the claimed features of a light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim, as recited in independent Claim 1. Specifically, Applicants respectfully assert that contrary to the Office Action's assertions, Yokoyama does not show or state forming an annular raised rim. Rather, Applicants respectfully assert that Yokoyama shows that the photo-conductive resin composition 9 is deposited as an annular ring, and that the resin composition is then spread flat by rotation of the substrate to form the flat second protective layer 6 (e.g., as shown in Figures 1 and 4).

Okada is directed to a phase change type optical disk. As shown in Figure 1, for example, of Okada, a thickness of a metallic reflecting layer 5 is increased from an outer periphery toward the inner periphery of the disk to obtain the optical disk which varies a cooling rate in a radial direction. The cooling rate is controlled by changing the film

¹ Page 3, paragraph 4 of section 5., of the Office Action.

² Column 3, lines 58-64.

thickness of the metallic reflecting layer 5 such that the thickness of the metallic reflecting layer 5 is increased from the outer periphery toward the inner periphery so that equal cooling conditions are obtained.³

Applicants respectfully assert that Okada does not teach or suggest the claimed features of a light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim, as recited in independent Claim 1. Specifically, Applicants respectfully assert that Okada does not show or state forming an annular raised rim.

As stated in MPEP § 2143.01, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves.” In this case, Applicants respectfully assert that the Office Action has not provided the required teaching, suggestion, or motivation to combine or modify the references of Nishida, Yokoyama, and Okada to provide the claimed features of a light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim, as recited in independent Claim 1. Rather, as discussed above, Applicants respectfully assert Nishida does not show or state a light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim, but rather at most shows an annular raised rim, that Yokoyama does not show or state an annular raised rim, and that Okada does not show or state an annular raised rim. Further, inasmuch as Okada may be characterized as showing a light-transmitting layer terminating at a radially inner periphery which forms a raised rim, Applicants respectfully note that the metallic reflecting layer 5 which appears to linearly increase in thickness (i.e., which is not annular) does so for the explicit purpose of providing equal cooling conditions in the radial direction. In addition, Applicants respectfully assert that the reflecting layer 5 of Okada is a metallic layer, and therefore is formed from a

³ English language abstract.

different material than the resin-based light-transmitting layer recited in independent Claim 1. Thus, Applicants respectfully assert that the only motivation for combining or modifying any teaching of an annular raised rim of Nishida to be provided on any teaching of a light-transmitting layer terminating at a radially inner periphery of Okada is provided by Applicants' disclosure, and not by either Nishida or Okada.

Applicants respectfully assert that the claimed features recited in independent Claim 1 can provide numerous advantages that are not provided by Nishida, Yokoyama, and Okada. By way of specific non-limiting examples, Applicants respectfully assert that the claimed features of a light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim can prevent the light-transmitting layer from adhering to an overlying disk sample, and can prevent contact traces from adhering to the light-transmitting layer.⁴

Thus, Applicants respectfully submit that the above-rejection of independent Claim 1 in view of Nishida, Yokoyama, and Okada is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps.⁵ Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness.⁶ Further, Applicants respectfully assert that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness."⁷ Therefore, Applicants respectfully assert that an improper "obvious to try"

⁴ Please see from page 23, line 30 to page 28, line 20, of Applicants' originally filed specification, including examples 1-5 and comparative example 1.

⁵ *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

⁶ *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

⁷ See Heading under MPEP 2143.01.

rationale has been applied in the Office Action.⁸ Specifically, Applicants respectfully assert that because none of Nishida, Yokoyama, and Okada teach or suggest the desirability of the claimed features of a light-transmitting layer terminating at a radially inner periphery which forms an annular raised rim as recited in independent Claim 1, the Office Action has not established a *prima facie* case of obviousness. Thus, Applicants respectfully assert that the rejection of independent Claim 1 under 35 U.S.C. § 103(a) is improper. Applicants respectfully request that the rejection of independent Claim 1 under 35 U.S.C. § 103(a) be withdrawn, and the allowance of independent Claim 1.

Applicants respectfully assert that Claims 2, 3, and 11-17 are allowable for the same reasons as independent Claim 1, from which they depend, as well as for their own features. Thus, Applicants respectfully request that the rejection of dependent Claims 2 and 3 under 35 U.S.C. § 103(a) be withdrawn, and the allowance of dependent Claims 2, 3, and 11-17.

Applicants respectfully assert that new independent Claim 18, as well as Claims 19 to 22 depending therefrom, are allowable for reasons similar to those of independent Claim 1. Thus, Applicants respectfully request the allowance of Claims 18-22.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-3 and 11-22 is earnestly solicited.

⁸ See MPEP 2145 X.B.

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Reply to Office Action of May 21, 2004

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

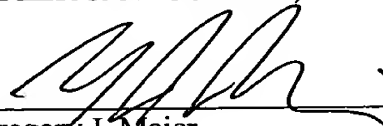
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Respectfully submitted,

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